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10/777,904	02/13/2004	Jun Hirai	248884US6	6087
22850	7590	05/12/2010		
OBLON, SPIVAK, MCCLELLAND MAIER & NEUSTADT, L.L.P. 1940 DUKE STREET ALEXANDRIA, VA 22314				EXAMINER
				DEGA, MURALI K
ART UNIT		PAPER NUMBER		
3621				
NOTIFICATION DATE		DELIVERY MODE		
05/12/2010		ELECTRONIC		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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<b>Office Action Summary</b>	<b>Application No.</b> 10/777,904	<b>Applicant(s)</b> HIRAI ET AL.
	<b>Examiner</b> MURALI DEGA	<b>Art Unit</b> 3621

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If no period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on **24 March 2010**.  
 2a) This action is **FINAL**.      2b) This action is non-final.  
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) **1-12** is/are pending in the application.  
 4a) Of the above claim(s) **None** is/are withdrawn from consideration.  
 5) Claim(s) \_\_\_\_\_ is/are allowed.  
 6) Claim(s) **1-12** is/are rejected.  
 7) Claim(s) \_\_\_\_\_ is/are objected to.  
 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.  
 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) All    b) Some \* c) None of:  
 1. Certified copies of the priority documents have been received.  
 2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

1) Notice of References Cited (PTO-892)  
 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)  
 3) Information Disclosure Statement(s) (PTO/SB/08)  
 Paper No(s)/Mail Date \_\_\_\_\_

4) Interview Summary (PTO-413)  
 Paper No(s)/Mail Date \_\_\_\_\_  
 5) Notice of Informal Patent Application  
 6) Other: \_\_\_\_\_

**DETAILED ACTION**

***Acknowledgements***

1. This Office action is in response to Applicant's response filed on 12 April 2010 ("April 2010 Response").
2. The April 2010 Response is in response to the Examiner's Final Office Action mailed on 24 March 2010 ("March 2010 Final Office Action").
3. The April 2010 Response contained claim amendments and "Remarks" (April 2010 Remarks").
4. The April 2010 Remarks argued that the March 2010 Final Office Action is improper because the March 2010 Final Office Action includes a new grounds for rejection that were not necessitated by Applicant's amendments filed on 18 November 2009 ("November 2009 Amendments").
5. The Examiner has reviewed the April 2010 Remarks, claims, November 2009 Amendments and file history. Based on the Examiner's review of the April 2010 Remarks, claims, November 2009 Amendments and file history, the Examiner agrees the March 2010 Final Office Action includes a new ground for rejection that were not necessitated by Applicant's November 2009 Amendments.
6. Because the March 2010 Final Office Action includes a new ground for rejection that were not necessitated by Applicant's November 2009 Amendments, the finality in the March 2010 Final Office Action is hereby withdrawn.
7. A new final office action is set forth below.
8. Claims 1-12 are pending.

9. Claims 1-12 have been examined.

***Claim Rejections - 35 USC § 103***

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. Claims 1-12 are rejected under 35 U.S.C. §103(a) as being unpatentable over Hiratsuka (U.S. 2004/0064380) in view of Akiyama et al. (U.S. 5,805,699).

12. With respect to claims 1, 10 and 12:

13. Hiratsuka discloses a contents copying management system ("Overall view of the system", Fig. 1) configured by connecting ("Communication network CN") a contents copying apparatus ("Personal computers" PCa1, PCa2,...) and a copying management device ("Server SV") by a network ("Communication network CN"), said contents copying apparatus comprising:

a. the controller ("CPU 1 centrally performs various controls", ¶ [0024]) further configured to acquire apparatus identifying information ("an apparatus number (PC number)" ¶ [0018]) specific to and indicating said contents copying apparatus itself;

b. a first transmission/reception section ("Communication interface", item 8 of Fig. 1B) that transmits ("send user information", step P1, Fig. 4A) said medium

identifying information and said apparatus identifying information ("an apparatus number (PC number)" ¶ [0018]) to said copying management device ("Server SV") as copying-related combination information;

c. the first transmission/reception section ("Communication interface", item 8 of Fig. 1B) further receives copying authorizing information ("control data Dc", ¶ [0007]) generated by said copying management device ("Server SV") on the basis of said copying-related combination information at the time of accessing said copying management device, after transmitting said medium identifying information ("server apparatus SV sends the copy control data Dc of the relevant contents as a reply", ¶ [0007])

d. and the controller ("CPU 1 centrally performs various controls", ¶ [0024]) further configured to control an operation of copying said contents in response to said copying authorizing information ("In accordance with the contents of the copy control data Dc, information processing terminal PC determines whether or not to copy the relevant contents into external apparatus", ¶ [0007])

e. said copying management device ("Server SV") comprising:

f. a database ("storing device 4 of the server SV stores", ¶ [0031]) that registers and stores ("the server SV stores personal information regarding each of the numerous users US (a, b, c, . . . ) registered in the server SV as user information Du...", ¶ [0031], [0044]-[0046]) said copying-related combination information ("Du, Db and Dc, Fig. 2) received from said contents copying

apparatus ("Personal computers" PCa1, PCa2,...) in advance ("registered in advance", [0007] and [0040]);

g. a control section ("Server SV") configured to compare said copying-related combination information ("Du, Db and Dc, Fig. 2) received at the time of access by said contents copying apparatus with said copying-related combination information registered in said database in advance ("registered in advance", ¶ [0007] and [0040]), that judges agreement or disagreement ("validated or invalidated") of said combinations of medium identifying information and apparatus identifying information ("an apparatus number (PC number)" ¶ [0018]), and that generates copying authorizing information ("control data Dc", ¶ [0007]) for authorizing an operation of copying the contents in response to agreement of said combinations but that generates copying non- authorizing information for not authorizing any operation of copying the contents in response to disagreement of said combinations ("copying process is validated or invalidated in accordance with the current contents of the copy control data Dc", ¶ [0038]);

h. and a second transmission/reception section that transmits said copying authorizing information ("control data Dc", ¶ [0007]) to said contents copying apparatus ("server SV reads the copy control data corresponding to the sent music reference number out from the music data purchase information area Db of the relevant user information Du of the storing device (HD) and sends the copy control data to the relevant terminal PC as a reply (S8)", ¶ [0056]).

- i. Hiratsuka discloses a copying controlling system using the copying apparatus number and user information but does not explicitly disclose use of medium identifying information.
- j. However Akiyama teaches a controller ("Medium identifier reading means 4" of Fig. 1) configured to acquire medium identifying information specific to and characterizing a recorded-contents-carrying original recording medium ("storage medium identifier reading means 4 reads out a storage medium identifier (IDk) recorded in the target storage medium 3", C 4, II. 12-14);
- k. Therefore, it would have been obvious to one of ordinary skill to combine the teachings of Hiratsuka and Akiyama in order to provide a copy control method and system using medium identifying information and the copying apparatus information, resulting in a more accurate and effective copy control method that prevents unauthorized copying by users and results in improved revenues for the content producers and distributors, since so doing could be performed readily and easily by any person of ordinary skill in the art, with neither undue experimentation, nor risk of unexpected results.
- l. Additionally, the Supreme Court in *KSR International Inc. v. Teleflex Inc.* (KSR) particularly emphasized "the need for caution in granting a patent based on the combination of elements found in the prior art," and discussed circumstances in which a patent might be determined to be obvious. Importantly, the Supreme Court reaffirmed principles based on its precedent that "[t]he combination of familiar elements according to known methods is likely to be

obvious when it does no more than yield predictable results." In this case, the combination of apparatus identifying information as disclosed by Hiratsuka and medium identifier information as disclosed by Akiyama would yield a predictable result, specifically: copying related combination information identifiable by the copying management device to validate (authorize) or invalidate (deny) copying operation by the contents copying apparatus . It would have been obvious to one of ordinary skill in the art to modify Hiratsuka to include Akiyama because the claimed invention is merely a combination of old elements, and in the combination each element merely would have performed the same function as it did separately. Furthermore one of ordinary skill in the art would have recognized that the results of the combination were predictable, therefore the combination has been deemed obvious.

14. With respect to claim 2:
15. Hiratsuka discloses wherein said controller ("CPU 1 centrally performs various controls", ¶ [0024]) is further configured to control reproduction of said copied contents according to said copying authorizing information ("In accordance with the contents of the copy control data Dc, information processing terminal PC determines whether or not to copy the relevant contents into external apparatus", ¶ [0007]).
16. With respect to claim 4:
17. Hiratsuka discloses wherein said controller ("CPU 1 centrally performs various controls", ¶ [0024]) is further configured to control copying of said contents according to

said copying authorizing information ("In accordance with the contents of the copy control data Dc, information processing terminal PC determines whether or not to copy the relevant contents into external apparatus", ¶ [0007]) and displays a predetermined warning image on a display when copying is not authorized according to said copying authorizing information ("the display 6 of the terminal PC display a message that "the music data cannot be sent because the music data are already copied", ¶ [0057]).

18. With respect to claim 5:

19. Hiratsuka discloses wherein said database ("storing device 4 of the server SV stores", ¶ [0031]) registers said medium identifying information ("the server SV stores personal information regarding each of the numerous users US (a, b, c, . . . ) registered in the server SV as user information Du...", ¶¶ [0031], [0044]-[0046]) said copying-related combination information ("Du, Db and Dc, Fig. 2) received from said contents copying apparatus ("Personal computers" PCa1, PCa2,...) according to a title of said contents on a title by title basis ("the list of items (music titles, numbers, etc.) of the already purchased music data Dmd stored in storing device 4", ¶ [0055]) when registering and storing in advance ("registered in advance", [0007] and [0040]) said copying-related combination information received from said contents copying apparatus and said control section is further configured to select said medium identifying information to be compared according to said title when it compares said copying-related combination information received at the time of said access of said contents copying apparatus with said copying-related combination information registered in advance in said database (¶¶[0031], [0032], [0034] and [0049] and Fig.2).

20. With respect to claims 6 and 7:

21. Hiratsuka discloses wherein said controller is further configured to generate the contents to be copied, convoluting said medium identifying information and said apparatus identifying information ("an apparatus number (PC number)" ¶ [0018]) into said contents, when copying said contents, and to control reproduction of said copied contents by taking out the medium identifying information and the apparatus identifying information from said copied contents, to transmit the combined information to said copying management device by said first transmission/reaction section and to receive said copying authorizing information generated by said copying management device on the basis of the combination of the medium identifying information and apparatus identifying information when reproducing said copied contents ("for each of the music data (1, 2, 3, . . . ), the music information Dm is made of a music reference number (music ID number) for specifying the relevant music data, an SMF (Standard MIDI File) representing the contents of the relevant music as well as lyric data, image data, and other data corresponding to the relevant music, as illustrated in the central two columns of FIG. 2. Here, the other data of each of the music data include the copy control data Dc representing the number of times the relevant music data can be copied, as shown by broken lines in the rightmost column. However, the copy control data Dc need not be stored for each of the music data if the same number (for example "2" (at the time of downloading)) is to be set, irrespective of the music, in the copy control data Dc", ¶ [0034]).

22. With respect to claim 8:

23. Hiratsuka discloses wherein said controller is further configured to encode the contents, using said apparatus identifying information as key, when carrying out an operation of copying said contents ("regarding the PC number, the server SV may impart a unique (single) number each time", ¶ [0018]).

24. With respect to claim 9:

25. Hiratsuka discloses a copying management device ("Server SV") comprising: a transmission/reception section that receives medium identifying information specific to and characterizing a recorded-contents-carrying original recording medium and apparatus identifying information ("an apparatus number (PC number)" ¶ [0018]) specific to and indicating a contents copying apparatus itself from said contents copying apparatus as copying-related combination information at the time of copying said contents by a network; a database that registers and stores said copying-related combination information received from said contents copying apparatus in advance; a control section configured to compare said copying-related combination information received at the time of access by said contents copying apparatus with said copying-related combination information registered in said database in advance, to determine agreement or disagreement of said combinations of medium identifying information and apparatus identifying information, to generate copying authorizing information for authorizing an operation of copying the contents in response to agreement of said combinations but to generate copying non-authorizing information for not authorizing any operation of copying the contents in response to disagreement of said combinations; and the transmission/reception section further transmits said copying

authorizing information to said contents copying apparatus, wherein said copying management device controlling copying of said contents by said contents copying apparatus from said recorded-contents-carrying original recording medium according to said copying authorizing information with respect to each recorded-contents- carrying original recording medium. (Also, refer to claim 1 rejection)

26. With respect to claim 11:

27. Hiratsuka discloses a contents copying apparatus ("Personal computers" PCa1, PCa2,..., Figs. 1A and 1B) comprising: a controller configured to acquire medium identifying information specific to and characterizing a recorded-contents-carrying original recording medium; the controller further configured to acquire apparatus identifying information ("an apparatus number (PC number)" ¶ [0018]) specific to and indicating said contents copying apparatus itself; a transmission/reception section configured to transmit said medium identifying information and said apparatus identifying information to a copying management device connected to it by a network as copying-related combination information; the transmission/reception section further configured to receive copying authorizing information generated after registration of said copying-related combination information by said copying management device by comparing said copying-related combination information transmitted at the time of a new access to said copying management device, after the transmitting said medium identifying information, with said copying-related combination information registered in advance, and to authorize an operation of copying the contents in response to agreement of said combinations of medium identifying information and apparatus

identifying information but not authorizing any operation of copying the contents in response to disagreement of said combinations from said copying management device; and the controller further configured to control the operation of copying according to said copying authorizing information. (Also, refer to claim 1 rejection).

28. With respect to claim 3:

29. Akiyama teaches wherein said medium identifying information is a characteristic of the printing surface of said recorded-contents-carrying original recording medium produced at the time of printing ("storage medium 3 has an individual storage medium identifier which is written at the factory before shipment", C 4, ll. 6-8), information of the signals on the recording surface of said recorded-contents-carrying original recording medium, the signals recorded on the recording surface, or a combination of one or more of: the characteristic of the printing surface of said recorded-contents-carrying original recording medium produced at the time of printing, information of the signals on the recording surface of said recorded-contents-carrying original recording medium, or the signals recorded on the recording surface. ("FIG. 3(B) is a diagram showing the record structure of the MO disc 12, where a storage medium identifier ID<sub>k</sub> (k=1,2, . . . ,m) is recorded. Although most part of the MO disc 12 can be freely written and/or read by the end users, the storage medium identifier ID<sub>k</sub> is written in a special part of the disc that is not rewritable. This storage medium identifier ID<sub>k</sub> may be a serial number which is assigned uniquely to each medium at the factory before shipment", C 5, ll. 29-36).

30. Therefore, it would have been obvious to one of ordinary skill to combine the teachings of Hiratsuka and Akiyama in order to provide a copy control method and

system using medium identifying information and the copying apparatus information, resulting in a more accurate and effective copy control method that prevents unauthorized copying by users and results in improved revenues for the content producers and distributors, since so doing could be performed readily and easily by any person of ordinary skill in the art, with neither undue experimentation, nor risk of unexpected results.

#### ***Response to Arguments***

31. The Applicants argue that "identifier SIDI in Akiyama does not identify a recording medium itself".
32. The argument is persuasive and the claim rejection is modified accordingly to reflect the medium identifier to be IDk.
33. The Applicants argue that "storage medium identifier IDk in Akiyama does not identify the contents copying apparatus itself".
34. The argument is persuasive and the claim rejection is modified accordingly to reflect the Apparatus identification number to be "apparatus number ("an apparatus number (PC number)" ¶ [0018]) of Hiratsuka.

#### ***Conclusion***

35. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

m. Also, refer to patents issued to Morioka et al. (US 6,526,010) and Mitui et al. (US 6,937,553) where use of medium identifying information being used to control content copying methods.

36. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 C.F.R. § 1.136(a).

37. A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 C.F.R. § 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

38. Any inquiry concerning this communication or earlier communications from the Examiner should be directed to MURALI DEGA whose telephone number is (571)270-5394. The Examiner can normally be reached on Monday to Thursday 7.00AM to 5.30 PM.

39. If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Andrew J. Fischer can be reached on 571-272-6779. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

40. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Murali K. Dega/  
Art Unit 3621  
May 2, 2010.